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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/392,028 09/08/99 SMITH

W RD-27419

EXAMINER

TM02/1018

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ART UNIT	PAPER NUMBER

2164

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10/18/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/392,028

Applicant(s)
Smith et al

Examiner
Daniel Felten

Art Unit
2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Sep 8, 1999

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-22 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-22 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 09/392,029. Although the conflicting claims are not identical, they are not patentably distinct from each other because each application is related to automating lending processes via a process management and workflow system which is coupled to a data repository within a monitoring system that receives, analyzes and records financial information.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Method claims 1-4 and apparatus claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Highbloom (US 5,23,315) in view of Hogan (US 2001/0013545 A1).

Regarding method claim 1 and apparatus claim 12:

Highbloom discloses a method for processing financial information process management and workflow system (see fig. 1) coupled to a data repository [18, 20] (*main and long term memory*), upon receipt of the financial information by the process management and workflow system, the method comprising the step of operating the process management and workflow system to record the financial information (see col. 6, ll. 1-33), evaluate current collateral information 10 (*via monitoring system*) (see col. 3, ll. 56-61), and evaluate current credit status (see col. 4, line 52 to col. 5, ll. 11).

1 Highbloom fails to disclose a method of processing a cash advance *request* in his
2 invention. Hogan discloses a method which includes processing a cash advance request via a
3 financial transaction card (see Hogan page 2, paragraph [0018]; page 5, claim 20; and page 6,
4 claim 37). Since Highbloom does disclose a computer readable medium 28 to exchange
5 financial transaction information (see *floppy disk*, col. 8, ll. 21-37), it would have been obvious
6 for an artisan of ordinary skill in the art at the time of the invention to substitute the financial
7 transaction card of Hogan (with the ability to make a cash advance request) for the floppy disk
8 found in Highbloom because an artisan would have considered such a substitution an art
9 recognized equivalent inasmuch as the both the floppy disk and the transaction card are used to
10 exchange financial information between the computer readable card/disk medium and the system.

11 Furthermore, a cash advance *request* is a mere extension of the teachings of Highbloom
12 so far as it is considered financial transaction information. Thus to employ such information on
13 Highbloom's floppy disk would be considered a matter of design choice to one of ordinary skill
14 in the art.

15
16 **Regarding method claim 2 and apparatus claim 13:**

17 the step of operating the process management and workflow system to evaluate whether the
18 collateral information is up-to-date (see Highbloom, Abstract, col. 4, lines 52-64).

1 **Regarding method claim 3 and apparatus claim 14:**

2 the collateral information is not up-to-date, said method further comprises the step of operating
3 the process management and workflow system to update the collateral information (see
4 Highbloom, Abstract, col. 4, lines 52-64).

5
6 **Regarding method claim 4 and apparatus claim 15:**

7 evaluating current credit status comprises the steps reviewing whether money is actually
8 available in a credit line, and whether a borrowing client's business is performing according to
9 expectations (see Highbloom, Abstract, col. 4, lines 65 to col. 5, ll. 11).

10
11 5. Method claims 5-11 and apparatus claims 16-22 are rejected under 35 U.S.C. 103(a) as
12 being unpatentable over Highbloom (US 5,23,315) as modified by Hogan (US 2001/0013545
13 A1) as applied to claim 1 as applied to claim above, and further in view of DeFrancesco et al
14 (US 5,878,403). The teachings of Highbloom and Hogan have been discussed above.

15
16 **Regarding method claim 5 and apparatus claim 16:**

17 Highbloom as modified by Hogan fails to disclose identifying dilution, reviewing advance rate,
18 and reviewing fraud possibilities.

1 DeFrancesco discloses a method wherein evaluating current credit status further
2 comprises the steps identifying dilution, reviewing advance rate, and reviewing fraud
3 possibilities (see DeFrancesco, col. 5, ll. 44-47; col. 7, ll. 32-39; col. 16, ll. 62 to col 17, ll. 11).

4 It would have been obvious for an artisan at the time the invention was made to employ
5 the teachings of DeFrancesco with the aforementioned features, to the teaching of Highbloom as
6 modified by Hogan because an artisan at the time of the invention would be concerned about the
7 accuracy and security of the financial transaction information being bi-directionally
8 communicated between customer and financial data sources. Thus to employ such features with
9 Highbloom as modified by Hogan would be considered an obvious extension to the teachings
10 Highbloom inasmuch as it would provide an alternative means to secure that the information
11 received and transmitted is correct. Thus such a modification would be an obvious expedient to
12 one of ordinary skill in the art.

13
14 **Regarding method claim 6 and apparatus claim 17:**

15 the method further comprises the step of operating the process management and workflow
16 system to initiate a review and approval process, and to either deny or approve the request (see
17 DeFrancesco, *application status*, fig. 3AJ ; col. 17, ll. 39-43; and col. 30 ll. 47 to col. 31, ll. 17).

Regarding method claim 7 and apparatus claim 18:

comprising the step of notifying a user of a request status (see DeFrancesco, *application status*, fig. 3AJ ; col. 17, ll. 39-43; and col. 30 ll. 47 to col. 31, ll. 17).

Regarding method claim 8, 9 and apparatus claim 19, 20:

if the request is approved, said method further comprises the steps of initiating a wire transfer of funds, and archiving wire transfer details; and if the request is approved, said method further comprises the step of notify the user that wire transfer is complete (see DeFrancesco, *application status*, fig. 3AJ ; col. 17, ll. 39-43; and col. 30 ll. 47 to col. 31, ll. 17).

Regarding method claim 10 and apparatus claim 21:

A method the process management and workflow system is coupled to client by a wide area network, and wherein receiving financial information comprises the steps of establishing a communication link between the accounting system and the process management and workflow system, and authenticating validity of the accounting system (see fig. 2).

Regarding method claim 11 and apparatus claim 22:

A method in accordance with Claim 10 wherein the wide area network is the Internet 104 (see fig. 1A, DeFrancesco et al, col. 17, ll. 57 to col. 18, ll. 22).

Conclusion

6. A list of cited references appears below not relied upon in this Office Action:

US Patents:

Campbell (US 4,408,203) discloses a security system for electronic funds transfer system

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor ***Vincent Millin*** whose telephone number is (703) 308-1065.

8. Response to this action should be mailed to:


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Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

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2 All Internet e-mail communications will be made of record in the application file. PTO
3 employees do not engage in Internet communications where there exists a possibility that
4 sensitive information could be identified or exchanged unless the record includes a properly
5 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
6 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
7 Trademark on February 25, 1997 at 1 195 OG 89.

8
9
10 
11 Daniel S. Felten
12 October 11, 2001


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